REMARKS

Claims 1-38 and 45-46 were rejected under 35 U.S.C. § 102 (e) as being anticipated by Ellis et al., (US2004/0117831 A1), hereinafter referred to as *Ellis*. This rejection is traversed.

Applicant assumes that the rejection under 35 U.S.C. § 102 (e) was made under sub-paragraph 1 since the cited reference is not a patent. The cited reference is the *Ellis* publication which incorporates an unpublished application, namely, McKissick et al., (U.S. Application No. 09/378,533, filed August 20, 1999), hereinafter referred to as *McKissick.*

What the Examiner has overlooked is that for a reference to actually be incorporatable into another patent application it must be a publicly available document. Unquestionably, the *McKissick* application was not available to any member of the public until such time as the Ellis application was published, as provided for in 37 C.F.R. § 1.14, which says in pertinent part:

vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ **1.19(b)**), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article **21(2)**. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (h) of this section.

Accordingly, since the *McKissick* application was **private** and thus not available to the public prior to the *Ellis* patent application publication date of **June 17, 2004**, the *McKissick* document is **not available** as a reference against the instant application which has a priority date of July 27, 2000. Nothing in the law allows a document to be effective as a reference **prior** to that document's public availability date.

Accordingly, since the *Ellis* publication is clearly an improper reference, Applicant need not make a detailed response to the rejected claims even though Applicant believes that the claims are distinguishable thereover. However, applicant understands that the Examiner could suspend prosecution on this application pending the actual publication of the *McKissick*

application. Should the Examiner desire to take such an approach, Applicant is willing to cancel claims 1-15 and 21-31 (claims 16-20 and 32-47 having been canceled by this amendment) for the purpose of placing those claims in a continuation application awaiting the publication of the *McKissick* application..

To this end Applicant has added new claims 47-54, which, as discussed below, Applicant believes to be allowable in view of the *McKissick* application should *McKissick* ever be published.

Discussion of New Claims 47-54

While not necessary for the reasons discussed above, Applicant will nonetheless distinguish claims 47-54 from the *McKissick* application.

Claim 47 is directed to the concept of adjusting the duration (stop time) of a recording of a program without user intervention. For example, as discussed beginning at paragraph [0061] of Applicant's specification, if a hockey game goes longer than the three hour expected duration, the recording time would be automatically extended. This concept is also discussed beginning at paragraph [0013] with respect to general programming. The *McKissick* reference does not in any manner address the automatic recording of programs, and specifically does not address changes in program duration. In fact, *McKissick* is specific about the fact that the recorder is user controlled. See, for example, *McKissick*, page 14 beginning at line 5 where *McKissick* lists remote devices and then adds, "or other suitable user input devices". Clearly then, *McKissick* neither teaches nor suggests that recording durations can be automatically changed when a program duration changes from an originally anticipated duration.

Claim 49 is directed to the concept of adjusting the actual recording times (start and stop times) of a preset recording when the scheduled communication time changes. For example, as discussed beginning at paragraph [0062] of Applicant's specification, if the start time of movie is changed (in the example it is changed because of a late running hockey game), the recording time for the movie would be automatically extended. As discussed above, the *McKissick* reference does not in any manner address the automatic recording of programs, in any manner and specifically does not address changing set times when a schedule changes.

Claim 50 is directed to a program transmission source sending start and stop times to recording equipment at the user's premises. As discussed above, this concept is not in any manner addressed by *McKissick* since the recorder control of *McKissick* is under the user's control and not under the control of the transmission entity.

Claim 52 is directed to the adjustment of programs for recording based on time zone changes for the user. Paragraph [0053] of Applicant's specification discusses such time zone changes. Nothing in *McKissick* addresses this concept in any manner.

Claim 53 is similar to claim 50 with the exception that claim 53 recites that the start and stop times are actually set in the recording equipment of the user. For the reasons set forth with respect to claim 50, claim 53 should be held allowable.

Claim 54 is directed to allowing a third party to develop entertainment content based on desires of the user. The creation of content to match a user request is discussed, for example, in Applicant's specification at paragraph [0032]. The *McKissick* application does not discuss a third party **developing** information content but rather, at best, in *McKissick* the third party makes non-scheduled content available. Presumably, the non-scheduled content is already existing content since nothing in *McKissick* says otherwise.

Based upon the discussion above, Applicant believes that newly added claims 47-54 are allowable and favorable action in that regard is earnestly solicited.

An IDS has been submitted with this Response to cite U.S. Patent No. 5,974,406 (hereinafter referred to as '406), dated October 26, 1999. The '406 patent was cited in a co-pending application which is a divisional from the same parent as the present application. Applicant does not believe the '406 reference to be material with respect to the claims of this Application and is being submitted to avoid any appearance of impropriety.

Because of the improper reference to Ellis (because the effective date of the incorporation of *McKissick* is after Applicant's filing date) the Examiner is urged not to make the next Office action Final if new art is cited against the newly added claims since Applicant is genuinely trying to place this application in condition for allowance.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 05708/P005D1/08008819 from which the undersigned is authorized to draw.

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Respectfully submitted,

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